PTO/SB/33 (07-05)
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number: 07844-613001 / P566
I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.	Application Number 10/680,930	Filed October 7, 2003
	First Named Inventor Viraj Chatterjee, et al.	
Date of Deposit	Art Unit 2629	Examiner Kevin M. Nguyen
Signature		
Typed or Printed Name of Person Signing Certificate		

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

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Jan. 29, 2008
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ Total of one form (plus five attached sheets) is submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Viraj Chatterjee, et al.	Art Unit	: 2629
Serial No.	: 10/680,930	Examiner	: Kevin M. Nguyen
Filed	: October 7, 2003	Conf. No.	: 7598
Title	: INDEPENDENT VIEWS GENERATED FOR MULTIPLE DISPLAY DEVICES BY A SOFTWARE APPLICATION		

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters is requested in view of clear legal or factual deficiencies in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 1-49 are pending, with claims 1, 18, 35, 46 and 48 being independent. Claims 1, 18, 35-39, 48 and 49 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Singhal et al. (U.S. 5,488,385, hereinafter Singhal). Independent claim 1 recites, "**identifying, by a software application** in a computing system, display characteristics of multiple display devices; and **generating, by the software application** in the computing system, simultaneous independent views of an electronic document on the display devices by **separately rendering the electronic document** to each of the display devices **based on the identified display characteristics** of the device." (Emphasis added.) Thus, it is the software application itself that performs the claimed identifying and generating. Singhal does not describe this claimed subject matter.

The Office asserts that an implementation of the invention of Singhal "can be expressed in terms of either computer program (software application) or a CPU 12 (hardware) implementation, the two being functionally equivalent of one another." (*See* 10-29-2007 Office Action at page 13.) However, Singhal goes into great detail in his Background section regarding the disadvantages of using multiple chip sets, and Singhal's invention specifically involves overcoming these disadvantages using software to emulate dual VGA controllers. Thus, Singhal itself teaches that hardware and software implementations are **not equivalent**.

With respect to the presently claimed subject matter, one of ordinary skill in the art would recognize that the use of a software application is **not equivalent** to the use of hardware. In claim 1, it is the software application that performs the claimed identifying and generating. This can result in significant advantages. For example, as described in the present disclosure, "A professional high-fidelity display presentation can be given from any low-end device, such as a personal digital assistant, and there is no need to know beforehand what kind of display device might be encountered when it comes time to make the presentation. [...] The data and/or the document format need not be specifically prepared for rendering to a particular target output device, and a presentation can be made to any target output device without specialized presentation hardware." (*See* Specification at ¶s 10-11.) As is readily understood by those in the field, a software application (or updates thereto) that performs operations can be downloaded over a network to a presenter when needed, but hardware cannot. Thus, hardware is **not equivalent** to software in the present context.

Moreover, assuming for the sake of argument that hardware is equivalent to software, Singhal does not teach that either the hardware or the software of his invention **identifies** display characteristics of multiple display devices. The display characteristics are stored in memory but are not **identified** by the hardware. The cited portion of Singhal (col. 5, lines 47-60) does **not** describe identifying display characteristics of multiple display devices. Rather, Singhal describes using previously provided display information to effect dual VGA controller emulation. There is no active identification of display characteristics of multiple display devices in Singhal.

In addition, Singhal **does not describe** generating **simultaneous independent views** of **an electronic document** on the display devices by **separately rendering the electronic document** to each of the display devices **based on the identified display characteristics** of the device, as recited in claim 1. It should be noted that "rendering" is a term of art in the software application field, which is commonly understood by those of ordinary skill in the art to mean, in general, the conversion of a high-level object-based description into a graphical image for display. Nothing in Singhal describes separately rendering an electronic document to generate simultaneous independent view of the electronic document.

The Office asserts that, "The term 'render' is to convert graphics from a file into visual form," and also that, "Singhal discloses the frame data for the separate display devices 52 and

54, col. 6, lines 36-37, and lines 56-60." (*See* 10-29-2007 Office Action at page 13.) It is respectfully pointed out the "frame data" in Singhal is **not** "a file." (*See e.g.,* Singhal at col. 6, lines 36-41 and 50-60.) Singhal says nothing about how to convert a file into the frame data that is stored in the frame buffer 58. Thus, under the Office's own interpretation of the term "render", Singhal does **not** describe **separately rendering an electronic document** to multiple display devices.

The Office also notes that, "Singhal teaches a notebook computer, col. 4, line 59, which is used to store any files in the memory, which implies an electronic document." (*See* 10-29-2007 Office Action at page 13.) Assuming for the sake of argument that Singhal does inherently disclose an electronic document, the rest of the disclosure in Singhal makes very clear that such an electronic document would be rendered to frame data, and the **frame data** is separately transferred to the CRT driver and the LCD controller. (*See* Singhal at col. 5, line 40, to col. 7, line 25.) Thus, nothing in Singhal teaches or suggests, "**generating** [...] **simultaneous independent views of an electronic document** on the display devices by **separately rendering the electronic document** to each of the display devices **based on the identified display characteristics** of the device." (Emphasis added.)

Independent claims 18, 35 and 48 include features similar to independent claim 1. For all of the above reasons, each of independent claims 1; 18, 35 and 48 should be allowable over Singhal. Dependent claims 36-39 and 49 should be allowable over Singhal based on the above arguments and the additional recitations they contain. For example, dependent claim 37 recites, "wherein the software application identifies the display devices that are currently interfaced with the data processing system by **periodically polling** display interface hardware." (Emphasis added.) The Office Action mailed 05-07-2007 fails to address this claimed subject matter, disregarding the claim language when making the rejection. (*See* 05-07-2007 OA at page 4.) The Final Office Action cites to col. 6, lines 6-19, as allegedly disclosing this limitation. However, nothing in this portion of Singhal, or any other portion of Singhal, describes **periodically polling** display interface hardware. The Office has failed to address this point in the Advisory Action. Thus, there is a clear legal or factual deficiency in the rejection of claim 37.

Dependent claim 49 recites, "software-application means for controlling the outputting software-application means based on **user** configuration." (Emphasis added.) The Office has

cited to col. 5, lines 51-60, and also col. 6, lines 2-5, of Singhal as allegedly disclosing this claimed subject matter. (*See* 10-29-2007 Office Action at page 14.) However, these cited portion of Singhal say nothing at all about enabling a **user** to control how the video control unit 50 or the control software of Singhal operate. The Office has failed to address this point in the Advisory Action. Thus, there is a clear legal or factual deficiency in the rejection of claim 49.

Claims 2-8, 11, 19-25, 28, 41 and 42 stand rejected as allegedly being unpatentable under 35 U.S.C. § 103(a) over Singhal in view of Terayama et al. (US 7,010,551). Terayama et al. fails to cure the deficiencies of Singhal. Thus, dependent claims 2-8, 11, 19-25, 28, 41 and 42 should be allowable over the cited art, based on the arguments presented above, and the additional recitations these claims contain. For example, claim 2 recites, "**rendering** [...] according to presentation tags [...] **indicating device-dependent rendering** to be applied." Nothing in Terayama et al. suggests that the tags **indicate** device-dependent rendering since the tags in Terayama et al. are not designed to specify which content is to be rendered to which display device. Rather, the method in Terayama et al. checks the tags to see if the indicated data is displayable on a limited-capability device. In other words, the information linking the data to a specific type of display device is in the software performing the method only, not the tags themselves. Thus, Terayama et al. does not teach or suggest the subject matter of claim 2 or its dependent claims 3 and 4. The Office has failed to address this point in the Advisory Action.

In addition, claim 3 recites, "wherein identifying the display characteristics comprises periodically re-identifying the display characteristics of the display devices, in conjunction with multiple iterations of the separate renderings of the electronic document to allow display devices to be added and removed dynamically." The cited portion of Singhal (col. 13, lines 50-51) simply states, "6. A display subsystem providing for the simultaneous redisplay of independent images to multiple independent display devices[.]" This does **not** describe periodically re-identifying the display characteristics of the display devices to allow display devices to be added and removed dynamically. The Office has failed to address this point in the Advisory Action. Thus, there are clear legal or factual deficiencies in the rejection of claims 2-4.

Claims 46 and 47 stand rejected as allegedly being unpatentable under 35 U.S.C. § 103(a) over Singhal in view of Okuley et al. (US 6,956,542). For reasons similar to those addressed above, it should be clear that Singhal does not describe a data processing system comprising a primary display device and **a software application** that **generates simultaneous independent**

views of an electronic document on the display devices **based on display characteristics** of the display device **as identified by the software application**, as recited in claim 46. Okuley et al. fails to cure the deficiencies of Singhal. Moreover, the cited portions of Singhal and Okuley fail to describe **a portion of a user interface that provides control over the independent views on the display devices both together and separately**, as recited in claim 46. Thus, independent claim 46 should be in condition for allowance, and dependent claim 47 should be allowable based at least on its dependence form claim 46.

With respect to the remaining rejections, neither Shih, Tafoya et al. nor Meyn et al. cure the deficiencies of Singhal. Thus, all of dependent claims 9, 10, 12-17, 26, 27, 29-31, 32-34, 40 and 43-45 should be allowable over the cited art, based on the arguments presented above, and the additional recitations these claims contain. For example, with respect to claim 12 the Office contends that the claimed user interface is inherent in Singhal's reference to "notebook computers" at col. 4, line 59. (*See* 10-29-2007 Office Action at page 9.) This inherency assertion has been specifically traversed and was not conceded, yet the Office has failed to provided sufficient evidence to clearly establish "that the missing descriptive matter is **necessarily present** in the thing described[.]" (See MPEP § 2131.01; emphasis added). Moreover, the actual claim language (generating a user interface **with the first view** that provides control over the independent views on the display devices **both together and separately**) has yet to be addressed by the Office. Thus, there exists a clear legal or factual deficiency in the rejection of claim 12 and its dependent claims 13-17.

In view of the above, all of the claims should be in condition for allowance. A formal notice of allowance is thus respectfully requested.

Please apply any necessary charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: January 29, 2008

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